

REMARKS

This Response is submitted in reply to the Office Action dated December 6, 2004. The Claims have not been amended. No fee is due in connection with this Response. Please charge deposit account number 02-1818 for any insufficiency or to credit any overpayment.

Claims 1, 3 to 5, 8, 9, 11 to 19 and 21 to 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,491,584 to Graham et al. ("*Graham*") in view of U.S. Patent No. 6,135,884 to Hedrick et al. ("*Hedrick*"). Claims 2, 6, 7, 10 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Graham* in view of *Hedrick* and in further view of U.S. Patent No. 6,203,429 to Demar et al. ("*Demar*"). Claims 25 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Graham* in view of *Hedrick* and in further view of U.S. Patent No. 6,533,658 to Walker et al. ("*Walker*"). Applicants respectfully disagree with and traverse these rejections for at least the reasons provided below.

Page 4 of the Office Action states the following motivation to combine *Hedrick* with *Graham*:

[o]ne would be motivated to combine the teachings of *Hedrick* with the disclosed invention of *Graham* in order to provide players with multiple opportunities to re-trigger the bonus game and heighten the overall excitement of the game.

Applicants respectfully submit that this is not a proper motivation to combine the references for at least the reasons stated below.

A. There is No Need to Modify *Graham* and Thus There is No Motivation to Combine *Hedrick* with *Graham*

The first paragraph of the "Summary of the Invention" of *Graham* states the following:

According to the invention, there is provided a gaming machine having a display means and a game control means arranged to control images displayed on the display means, the game control means being arranged to play a game wherein random events are caused to be displayed on the display means and, if a predefined winning event results, the machine awards a prize, the gaming machine being characterised in that if the predefined result includes a trigger condition which results in an initial series of free games awarded to a player and, during the initial series of free games, another trigger condition arises, a subsequent series of free games, including a bonus feature, is awarded and implemented immediately during the existence of the initial series of free games with the bonus feature applicable to said subsequent series of free games being applied to the remaining games of the initial series of free games as well as to the games of the subsequent series of free games. (Emphasis added)(Col. 1, lines 29 to 45).

As described in *Graham*, the trigger condition causes the gaming device to provide the initial series of free games to the player. The player then plays the initial series of free games. If another trigger condition occurs while the player is playing the initial series of free games, the gaming device provides additional free games to the player (i.e., a subsequent series of free games). The additional free games include a bonus feature. The additional free games are added to the remaining number of initial free games provided to the player. The bonus feature is applied to those remaining initial free games as well as to the additional free games provided to the player.

The first occurrence of the trigger condition in *Graham* causes the gaming device to provide the initial free games to the player, and the second occurrence of the trigger condition in *Graham* causes (a) the gaming device to provide the additional free games to the player, and (b) to provide a bonus feature applied to those additional free games and any remaining initial free games.

The second paragraph of the "Summary of the Invention" of *Graham* further defines an "initial bonus feature" in the game.

In a preferred embodiment of the invention, the game includes an initial bonus feature awarded during the initial series of free games. Then, when the subsequent series of free games occurs, the bonus feature of the subsequent series of free games supersedes the initial bonus feature applicable in respect of the remainder of the games of the initial series so that the bonus feature applicable to the subsequent series of free games applies to all the remaining free games. (Col. 1, lines 46 to 53).

This paragraph describes a preferred embodiment of *Graham* which includes an initial bonus feature for the initial series of free games. When the subsequent series of free games is provided to the player (i.e., after the second occurrence of the trigger condition), the bonus feature supersedes or replaces the initial bonus feature for any remaining initial free games and for the subsequent or additional free games.

The third and fourth paragraph of the "Summary of the Invention" section of *Graham*: (a) define a "further series of free games" and a "further bonus feature;" (b) defines the repetitive or looping functionality of this game scheme; and (c) defines a potential limit on the looping feature.

It will be appreciated that, in the subsequent series of free games, if the trigger condition again arises to trigger a further series of free games, the further series of free games has a further bonus feature associated with it. The further bonus feature may supersede the bonus feature of the remaining games of the subsequent series of free games as well as any remaining games of the initial series of free games.

The awarding of yet further bonus features when additional free games are triggered may occur, optionally, a finite number of times. (Col. 1, lines 54 to 65).

These paragraphs describe the repetitive or looping functionality of the game scheme. Specifically, the third paragraph describes that each subsequent occurrence of the trigger condition (such as the third occurrence of the trigger condition) causes the gaming device to provide a further series of free games to the player and also causes the gaming device to provide a further bonus feature which is for each of the further free games and each of the remaining free games from the initial series and the additional series. Thus, each subsequently obtained bonus feature supersedes the previous bonus feature for all of the remaining games as further described in the fourth paragraph. *Graham* thus describes providing additional series of free games and bonus features for each "trigger condition" that occurs in the free games.

Graham clearly provides a player with multiple opportunities to re-trigger the bonus game by enabling the player to obtain subsequent series of free games and a bonus feature each time the same trigger condition occurs in one of the series of free games. *Graham* provides a straightforward method of providing the re-trigger in each

free game. A person of ordinary skill in the art would not see a need to add additional ways to re-trigger in the free spin mode. Accordingly, it is respectfully submitted that a person of ordinary skill in the art would not be motivated to add *Hedrick* to *Graham* to “provide players with multiple opportunities to re-trigger the bonus game” since the *Graham* game already has this feature.

B. General Statements or Reasons Cannot be Used as a Motivation to Combine References

The Office Action states that one would be motivated to combine *Graham* and *Hedrick* because the combination would “. . . heighten the overall excitement of the game.” (See the Office Action, page 4). Applicants respectfully submit that general statements, such as this one provided in the Office Action, which are used as the motivation to combine references are not legally proper under Federal Circuit law.

Obviousness can only be established by combining the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143.01. The Patent Office must show the “reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art” and combine those elements in the same manner as the claimed invention. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). These “reasons” need to be specific reasons, not general overarching reasons for combining two references or groups of references. There are three possible sources for determining whether a motivation to combine references exists: (1) the nature of the problem to be solved, (2) the teachings of the prior art, and (3) the knowledge of persons of ordinary skill in the art. MPEP § 2143.01; *In re Rouffet*, 47 U.S.P.Q.2d at 1458. The Office Action does not provide a specific explanation for any of these reasons.

For at least the above reasons, Applicants respectfully submit that the general statement used as the motivation to combine the references in the Office Action is thus legally improper. Therefore, the obviousness rejection is improper and should be withdrawn.

C. The Office Action Used Impermissible Hindsight to Re-construct the Claimed Invention

It is impermissible to use the claims as an instruction manual or "template" to piece together the teachings of the prior art to render a claimed invention obvious. See *Sensonics, Inc. v. Aerosonic Corp.*, 38 U.S.P.Q.2d 1551, 1554 (Fed. Cir. 1996). "Virtually all [inventions] are combinations of old elements." *In re Rouffet*, 47 U.S.P.Q.2d at 1457. An examiner may often find every element of a claimed invention in the prior art. However, the invention "must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made" without hindsight or knowledge of the invention. *Sensonics, Inc. v. Aerosonic Corp.*, 38 U.S.P.Q.2d at 1554. This is especially important in the case of less complex inventions where the "very ease with which the invention can be understood" may cause one to use hindsight "wherein that which only the inventor taught is used against its teacher." *In Re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Thus, the best argument against "hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine [the] prior art references." *Id.*

It is respectfully submitted that the Office Action is using improper hindsight to construct the claimed invention by selecting and combining elements from *Graham* and *Hedrick* to achieve the claimed invention. Therefore, the obviousness rejection of Claims 1 to 4 should be withdrawn.

For at least the reasons provided above, the combination of *Graham* and *Hedrick* does not render the claimed invention obvious because the Office Action does not provide proper motivation to combine these references. Furthermore, the Office Action used improper hindsight to select and combine elements from *Graham* and *Hedrick* to teach the invention defined by Claim 1. Therefore, Claim 1 and Claims 2 to 4, which depend from Claim 1, are each in condition for allowance.

Independent Claims 5, 14, 15, 16, 17, 19, 21 and 23 include certain similar elements to Claim 1, and specifically, the element of an accumulator in the secondary game which is adapted to accumulate secondary game retriggering symbols, wherein a secondary game retrigger is provided to a player when a player accumulates a plurality

of secondary game retriggering symbols in at least two activations of the secondary game. Accordingly, for at least the reasons provided above, Claims 5, 14, 15, 16, 17, 19, 21 and 23, and Claims 6 to 13, 18, 20, 22, 24 to 26, which depend therefrom, are each in condition for allowance.

Claims 2, 6, 7, 10 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Graham* in view of *Hedrick* and in further view of *Demar*. For the reasons stated above, the general statement in the Office Action to combine *Graham*, *Hedrick* and *Demar* by providing "gaming players with higher payouts in bonus games and heighten the exhilaration of the game" is legally insufficient. Furthermore, Claim 2 depends from Claim 1. Claims 6, 7 and 10 depend from Claim 5 and Claim 20 depends from Claim 19. Therefore, Claims 2, 6, 7, 10 and 20 are allowable for at least the reasons set forth above with respect to Claims 1, 5 and 19 because *Graham*, *Hedrick* and *Demar* are not properly combinable. Accordingly, the combination of *Graham*, *Hedrick* and *Demar* does not disclose, teach or suggest the novel elements of Claims 2, 6, 7, 10 and 20 in combination with the novel elements of Claims 1, 5 and 19, respectively.

Claims 25 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Graham* in view of *Hedrick* and in further view of *Walker*. Claims 25 and 26 depend from Claim 23. Applicants respectfully submit that Claims 25 and 26 are allowable for at least the reasons set forth above with respect to Claim 23 because *Graham*, *Hedrick* and *Walker* are not properly combinable and therefore do not disclose, teach or suggest the novel elements of Claims 25 and 26 in combination with the novel elements of Claim 23.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

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